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EXAMINER

ROSSI, J

ART UNIT

PAPER NUMBER

2122

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/458,849

Applicant(s)
SCHILLER

Examiner
Jeffrey Allen ROSSI

Art Unit
2122



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Dec 9, 1999

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-42 is/are pending in the application.

4a) Of the above, claim(s) NONE is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-42 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to the following communications: the application, filed 1999-12-09.
2. The disposition of claims is as follows: 1-43 (pending); 1,11,23, and 34 are independent.
3. The group art unit of the Examiner handling your case is 2122. Please use the most recent art unit information in order to assist us in responding in a more timely manner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

Dependent claims not explicitly discussed, *infra*, are rejected based on their dependency on a rejected base claim.

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5. Claims 1-22, and 27-32-rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Per independent claims 1 & 11, and dependent claim 27 the use of "behavior" is repugnant to its generally accepted meaning. Applicant uses "behavior" to refer to software functions, or the resulting changes in operation of those functions. The generally accepted meaning of behavior refers to the actions of a human being. When referring to software, it is generally used to indicate artificial intelligence. In the present case, the Examiner was not able to uncover any artificial intelligence in the present application. Therefore, the use of the term "behavior" in the manner claimed by Applicant would generally confuse the person of ordinary skill in the art (PHOSITA) as to what was being claimed. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

7. Claims 1-10, 12, and 34-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Per independent claims 1 & 34 and dependent claim 12; the metes and bounds of "traditional picture frame" cannot be discerned from the disclosure. Many television sets have "traditional picture frames". Furthermore, the metes of "traditional" cannot be discerned. Does

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this mean neo-classic and art-nouveau picture frames would not be covered by the breadth of this claim? These are questions that must be clear from reading the claims in light of the specification. Furthermore, what is generally considered "traditional" depends on ones cultural bias.

The Examiner believes that the Applicant is attempting to claim "a frame ornamentally designed explicitly to reassemble those that circumscribe printed photographs". The Examiner notes that many television frames and LCD frames are similar to those "traditionally" used for photographs.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Dependency of claims has been indicated with parentheses (). It has been used by the Examiner to indicate in shorthand the explicit incorporation of all rationale regarding the rejected parent claims.

11. Claims 1, 3, 5, 11-13, and 17 are rejected under 35 U.S.C. 102(a) as anticipated by Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIEKEN.

12. Per independent claim 1; HAGIWARA SYS-COM discloses: A system for distributing data comprising:

one or more frame devices (FIG. 6) configured to operate according to behavior characteristics, said one or more frame devices each having a border region modeled to resemble a traditional picture frame ("still image data"—ABSTRACT, element 60—FIG. 6);

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a data repository having image data (still image data—ABSTRACT, “storage media... are inserted into an insertion opening 21”—ABSTRACT);

an interconnection fabric coupled to said one or more frame devices (inherent...”reads data with file number n from the storage media”—ABSTRACT) , said interconnection fabric configured to relay said image data from said data repository to said one or more frame devices when said one or more frame devices automatically issues a request for said image data (“when a replay button 10 at an operating unit 10 is operated {sic.}, a processing unit reads data with file number n...” —ABSTRACT).

Per the claimed “behavior characteristics” it is noted that —storage means... which stores multiple playback programs corresponding to the recording methods for the various data stored in the recording medium... still image data... moving image data... and sound data contained in the recording means”—page 2, lines 1-3 and 5-7.¹

If Applicant disagrees that the recitation is clearly one of operating according to “behavior” characteristics, is noted that it was notoriously well-known in the art of photo display to associate “behavior characteristics” with photograph files. This was described by LIPS GLOEILAMPENFABRIKEN, wherein auxiliary software functions are appended to photo files (Abstract), which control presentation behavior of the picture (orientation”—page 14, lines 20-22; shifting—page 15, lines 15-16; picture processing operations—page 15, lines 25-32 et seq. and “display sequence”—page 16, lines 1-9; page 17, lines 2025 selection criteria—page 19,

¹ As translated by Steve SPAR of the United States Patent Office 04/2001... full translation pending

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lines 1-17; software—col. 21, lines 1-17). It would have been obvious to a Person Having Ordinary Skill In The Art, i.e., PHOSITA, at the time of the invention to combine the auxiliary data of LIPS GL. with the frame device of H. SYS-COM by including control information in the storage files 21 of H. SYS-COM in order to allow for proper orientation of picture frames and increased control over the presentation of the photographs as motivated by LIPS GL. (*idem. to previous citations*).

It is noted that Applicant has chosen to claim “interconnection fabric” in lieu of network. “Interconnection fabric” is deemed broader than a network, and this “broadest reasonable interpretation” includes the connection buses connecting storage means 21 to CPU 31 of HAGIWARA SYS-COM, even though a “network” is not disclosed *per se*.

13. Per dependent claim 11, this is substantially a method claim directed to the apparatus of independent claim 1, *supra*. In order to avoid excessive copy and paste, the arguments regarding independent claim 1 are hereby incorporated via reference. It is noted that HAGIWARA SYS-COM is configured to operate using “smart media” delineated, i.e., memory stick like devices which would have been entailed obtaining an image from any one of many data sources, including computers and digital cameras.

14. Per dependent claim 3 (1) and 5(1); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN demonstrates “wherein said one or more frame devices stores said behavior characteristics in one or more behavior modules” and “in said data repository” (*inherent* in the operating software of HAGIWARA SYS-COM and

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covered in the obvious rejection, supra, since the image files and operating parameters of the combined device would have been stored in the storage media 1 with the picture data—FIG. 6 of H. SYS-COM).

15. Per dependent claim 12 (11) HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN demonstrates claimed traditional picture frame (FIG. 6 of HAGIWARA SYS-COM).

16. Per dependent claim 13 (11), the device of HAGIWARA SYS-COM inherently has a unique identifier (i.e., serial number).

17. Per dependent claim 17 (11); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN demonstrates “wherein said one or more frame devices stores said behavior characteristics in one or more behavior modules” (*inherent* in the operating software of HAGIWARA SYS-COM and covered in the obvious rejection, supra, since the image files and operating parameters of the combined device would have been stored in the storage media 1 with the picture data—FIG. 6).

18. Claims 15 is rejected, under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIKEN.

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19. Per dependent claim 15 (11), it was notoriously well-known in the art to filter picture data. it would have been obvious to PHOSITA at the time of the invention to filter image data of HAGIWARA SYS-COM in order to better allow the user to select desired pictures.

20. Claims 2, 4, 9, 18, and 20-22 are rejected under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIKEN and further in view of IKEDA et al, US 6,111,586 A (08/2000), hereinafter IKEDA.

Per dependent claim 2 (1); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN discloses claimed interface for manipulating the JPEG pictures (See operation unit 10—ABSTRACT of HAGIWARA SYS-COM, JPEG—page 5, line 6; and MPEG—page 5, line 17). However, the recitation as understood w/o full translation fails to disclose claimed “picture box”. It is noted that this device is a JPEG image viewer, i.e. a ‘picture frame’; which describes technologies behind LUKIS™ JPEG image Viewer (see supplementally cited material—for reference only and a better understanding of the technical endeavor).

IKEDA on the other hand, demonstrates the notoriously well-known method of employing a photo-box to organize electronic photographs, e.g., JPEG images—see ST5, FIG. 11., FIG. 14, col. 10, lines 49-53, col. 11, lines 16, 22-26, 34-35, 40, and 41-45; vol. 12, lines 33). it would have been obvious to PHOSITA to combine IKEDA with the combined device

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described in the rejection of independent claim 1, supra, in order to organize the pictures of HAGIWARA SYS-COM and LIPS in order to control order and content of displayed images, and in order to arrange the JPEG images of the combined device.

21. Per dependent claim 4 (2); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN and IKEDA demonstrates input to the picture box modifying the behavior characteristics (operating feed button and return button...—Abstract of HAGIWARA SYS-COM). Alternatively, LIPS GLOEILAMPENFABRIKEN demonstrates changing viewing parameters of a photo display device via an input unit (page 31, lines 11-20). It would have been obvious to PHOSITA to combine the operator interface functions of LIPS GLOEILAMPENFABRIKEN with HAGIWARA SYS-COM in order to increase the user options of the presentation of the photos of HAGIWARA SYS-COM.

22. Per dependent claim 9 (2); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN, this is implicit in the setting of sequence parameters in both HAGIWARA and LIPS, wherein pictures are sequenced and would have been retrieved at specified intervals

23. Per dependent claim 18 (17) HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN lacks claimed picture box to change behavior characteristics. However, the combined device does suggest changing behavior characteristics via user interface (Abstract of HAGIWARA SYS-COM and page 32, lines 11-20 of LIPS...). It is noted that this device is a JPEG image viewer, i.e. a 'picture frame'; which describes technologies behind

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LUKIS JPEG image Viewer (see supplementally cited material—for reference only and a better understanding of the technical endeavor).

IKEDA on the other hand, demonstrates the notoriously well-known method of employing a photo-box to organize electronic photographs, e.g., JPEG images—see ST5, FIG. 11., FIG. 14, col. 10, lines 49-53, col. 11, lines 16, 22-26, 34-35, 40, and 41-45; vol. 12, lines 33). it would have been obvious to PHOSITA to combine IKEDA with the combined device described in the rejection of independent claim 1, *supra*, in order to organize the pictures of HAGIWARA SYS-COM and LIPS in order to control order and content of displayed images, and in order to arrange the JPEG images of the combined device.

24. Per dependent claim 20 (18) this is implied by the above combination in the rejection of dependent claim 18, *supra*, because at least some of the behavior characteristics would have been stored by the image capture device, e.g., orientation (See LIPS... abstract).

Per dependent claim 21(18) and 22(18) this is implied in the combination employed to reject dependent claim 18, *supra*, since auxiliary information includes sequence information as described above (See LIPS... page 18, lines 30-32; page 16, lines 4-7; SEQ—page 17, line 20 *et seq.*).

25. Claims 6 is rejected under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIEKEN, and further in view of WO 99/04342 A1 (01/1999) to WEBTV.

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26. Per dependent claim 6 (5); HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN fails to demonstrate claimed: wherein said one or more frame devices periodically obtains an update for said one or more behavior modules by obtaining said behavior characteristics from said data repository. WEBTV™ on the other hand, demonstrates updating both still images and firmware over a network (see ABSTRACT, page 11, lines 30-34). It would have been obvious to PHOSITA at the time of the invention to modify HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN to obtain both pictures and firmware over a network in order to allow families to share photos and in order to provide the latest software upgrades to the combined device of claim 5. The motivation to modify the combined device to a network would have come from Philips "Visions of the Future", which describes a picture frame for sharing family photos over a "family network". Thus, as can be seen by Philips, the motivation for modifying HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN to transmit pictures over a network (and correspondingly firmware updates as taught by WEBTV™) would have been to reduce feelings of separation and isolation by sharing family photos (and consequently firmware as was notoriously well-known to do with networked appliances) over a "family network".

27. Claims 7 and 19, are rejected under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIKEN and further in view of IKEDA et al, US 6,111,586 A (08/2000),

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hereinafter IKEDA and ANONYMOUS, "Visions of the Future," *Blaricum, Neatherlands: V+K Publishing* No. ISBN 90 6611 591-2, pp. 12-13, 12/1996 (reprinted 1998).

28. Per dependent claim 7 (2); HAGIWARA SYS-COM fails to show user authentication. This was notoriously well-known in the field of networked devices. HAGIWARA SYS-COM lacks the recitation of hooking up its picture frame to the network, and LIPS GLOEILAMPENFABRIKEN, on the other hand, demonstrates the notoriously well-known method of connecting a multimedia device to a network (FIG 8). It would have been obvious to PHOSITA at the time of the invention to modify HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN and IKEDA to obtain both pictures over a network in order to allow families to share photos to the combined device of claim 1. The motivation to modify the combined device to a network would have come from Philips "Visions of the Future", which describes a picture frame for sharing family photos over a "family network". Thus, as can be seen by Philips, the motivation for modifying HAGIWARA SYS-COM, LIPS GLOEILAMPENFABRIKEN and IKEDA to transmit pictures over a network would have been to reduce feelings of separation and isolation by sharing family photos over a "family network". The claimed "user authentication" would have been obvious in light of networking the combined device of claim 1 in order to prevent misidentification of the user on the network and potential "security" breaches of embarrassing family photos being sent to strangers' frame devices.

29.

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30. Per dependent claim 19(18); HAGIWARA SYS-COM in the combination described, supra, fails to show user authentication. This was notoriously well-known in the field of networked devices. HAGIWARA SYS-COM lacks the recitation of hooking up its picture frame to the network, and LIPS GLOEILAMPENFABRIKEN, on the other hand, demonstrates the notoriously well-known method of connecting a multimedia device to a network (FIG 8). It would have been obvious to PHOSITA at the time of the invention to modify HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN and IKEDA to obtain both pictures over a network in order to allow families to share photos to the combined device of claim 1. The motivation to modify the combined device to a network would have come from Philips "Visions of the Future", which describes a picture frame for sharing family photos over a "family network". Thus, as can be seen by Philips, the motivation for modifying HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN to transmit pictures over a network would have been to reduce feelings of separation and isolation by sharing family photos over a "family network". The claimed "user authentication" would have been obvious in light of networking the combined device of claim 1 in order to prevent misidentification of the user on the network and potential "security" breaches of embarrassing family photos being sent to strangers' frame devices

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31. Claim 8 is rejected under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIEKEN and further in view of IKEDA et al, US 6,111,586 A (08/2000), hereinafter IKEDA and Wo 95/31872 (11/1995) to PHILIPS ELECTRONICS, M.N.V., hereinafter the PHILIPS patent publication.

32. Per dependent claim 8(2), HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIEKEN and IKEDA in combination suggests transmitting input to the data repository, however it is merely implied by the combination. The PHILIPS patent publication, on the other hand, explicitly suggests playing back multimedia via interactive commands sent to a remote server (ABSTRACT). It would have been obvious to PHOSITA at the time of the invention to modify the combined device of claim 2 to send interactive commands to a remote database in order to reduce the processing power required to operate a small appliance as suggested by PHILIPS.

33. Claims 10, 14, and 16 are rejected under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIEKEN and further in view of ANONYMOUS, "Visions of the Future," *Blaricum, Neatherlands: V+K Publishing* No. ISBN 90 6611 591 2, pp. 12-13, 12/1996 (reprinted 1998).

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34. Per dependent claim 10(3), HAGIWARA SYS-COM or alternatively HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN lacks sending a request to a content provider.

Philips "visions of the future" suggests hooking a frame device to a content provider, *i.e.*, family network. It would have been obvious to PHOSITA to retrieve image data from a content provider in the combined device of dependent claim 3, in order to reduce feelings of separation and isolation of family members as suggested by "Visions of the Future".

35. Per dependent claim 14(11) HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN lacks image data associated with a unique identifier. However, this is implicit in the attachment of HAGIWARA to a network, since a device MUST have identified itself uniquely to a network for communicating. Philips "Visions of the Future" demonstrates connecting an electronic picture frame to a "family network" in order to exchange pictures. It would have been obvious to PHOSITA at the time of the invention to attach HAGIWARA SYS-COM to a network, and hence associate image data with an address, because it was explicitly demonstrated to attach a picture frame device to a family network by Philips in order to reduce isolation felt among family members.

36. Per dependent claim 16(15) HAGIWARA SYS-COM AND LIPS GLOEILAMPENFABRIKEN fails to show user authentication for the filtering of claim 15. This was notoriously well-known in the field of networked devices. HAGIWARA SYS-COM lacks the recitation of hooking up its picture frame to the network, and LIPS GLOEILAMPENFABRIKEN, on the other hand, demonstrates the notoriously well-known

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method of connecting a multimedia device to a network (FIG 8). It would have been obvious to PHOSITA at the time of the invention to modify HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN and IKEDA to obtain both pictures over a network in order to allow families to share photos to the combined device of claim 1. The motivation to modify the combined device to a network would have come from Philips "Visions of the Future", which describes a picture frame for sharing family photos over a "family network". Thus, as can be seen by Philips, the motivation for modifying HAGIWARA SYS-COM and LIPS GLOEILAMPENFABRIKEN to transmit pictures over a network would have been to reduce feelings of separation and isolation by sharing family photos over a "family network". The claimed "user authentication" would have been obvious in light of networking the combined device of claim 1 in order to prevent misidentification of the user on the network and potential "security" breaches of embarrassing family photos being sent to strangers' frame devices

37. Claims 23-25, 27 and 29 are rejected under 35 U.S.C. 102(a) as anticipated by Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of HEATHER NEWMAN FREE PRESS STAFF, W., "Nifty Ways You Can Soup up Your Machine," *Detroit Free Press* No. --, pp. 3E, 08/1999..

38. Per independent claim 23, HAGIWARA SYS COM discloses

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computer readable program code configured to obtain image data from a data source ("storage media containing still data." abstract; JPEG—page 5, line 6); computer readable program code configured to populate a data repository with said image data ("storage media containing image data—abstract); computer readable program code configured to respond to a request for said image data by transmitting said image data from said data repository to one or more frame devices ((“converted by a video decoder into video RAM... —Abstract).

The Examiner believes that each and every element is identically disclosed, since HAGIWARA SYS-COM inherently discloses software for writing and reading memory sticks.

If the Applicant disagrees with this interpretation, it is noted that the software for writing to/ and reading from computer memory cards was known (“using a digital camera that has compact flash cards that you can stuff right into the JPEG viewer or by using one of Lukis’ compact flash to PC connection devices”—NEWMAN approx paragraph 1. It would have been obvious to PHOSITA at the time of the invention to employ software for writing to the memory cards and or to the PC connection device of HAGIWARA SYS-COM because it was explicitly suggested by NEWMAN and implied that it was already in use.

39. Per dependent claim 24 (23) HAGIWARA SYS-COM or alternatively H. SYS-COM and NEWMAN disclose all elements as previously applied in the rejection of independent claim 23, supra. Claimed “data source has permission to populate said data repository is inherent in the memory stick of H. SYS-COM because it MUST have contained code to check if the stick was compatible. Alternatively, it would have been obvious to PHOSITA in the PC to flash

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connection embodiment described supra of HAGIWARA SYS-COM because it is notoriously well-known to check if an application had permission to write to a memory device before actually writing to it in order to prevent software crashes.

40. Per dependent claim 25, a unique identifier, e.g., serial number, is inherent in HAGIWARA SYS-COM.

41. Per dependent claim 27(23); claimed "behavior characteristics" are inherent in H. SYS-COM because it inherently has operating software to operate the buttons otherwise it would not have worked.

Per dependent claim 29(27); the claimed software communicated to the device is suggested by the PC connection of the combined device. It was notoriously well-known to update the operating system of network appliances. It would have been obvious to PHOSITA at the time of the invention to update the firmware of HAGIWARA SYS-COM via network in order to ensure the latest OS is in the frame of H. SYS-COM to insure compatibility with latest picture formats.

42. Claims 26 and 33 are rejected under 35 U.S.C. 102(a) as anticipated by Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of HEATHER NEWMAN FREE PRESS STAFF, W., "Nifty Ways You Can Soup up Your Machine," *Detroit Free Press* No. --, pp. 3E, 08/1999 and ANONYMOUS, "Visions of the

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Future," *Blaricum, Neatherlands: V+K Publishing* No. ISBN 90 6611 591 2, pp. 12-13, 12/1996 (reprinted 1998).

43. Per dependent claim 26(23); the combination described in the rejection of dependent claim 23 fails to set forth that the unique identifier is associated with image data. However, this is implied by connecting H. SYS-COM to a network, since the frame device must be addressed. The method and motivation for putting H. SYS-COM was set forth in excruciating detail above in this action, and therefore will not be repeated, since it would amount to a tedious copy/ paste. It would have been obvious to PHOSITA to put H. SYS-COM on a network and uniquely address it in order to decrease the loneliness of family members as set forth, supra.

44. Per dependent claim 33(23); H. SYS-COM and NEWMAN lacks the data being supplied by a content provider. Philips "visions of the future" suggests hooking a frame device to a content provider, i.e., family network. It would have been obvious to PHOSITA to retrieve image data from a content provider in the combined device of dependent claim 3, in order to reduce feelings of separation and isolation of family members as suggested by "Visions of the Future".

45. Claims 28, and 30 rejected under 35 U.S.C. 102(a) as anticipated by Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of HEATHER NEWMAN FREE PRESS STAFF, W., "Nifty Ways You Can Soup up Your

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Machine," *Detroit Free Press* No. --, pp. 3E, 08/1999 and further in view of IKEDA et al, US 6,111,586 A (08/2000), hereinafter IKEDA

46. Per dependent claim 28 (27); H. SYS-COM and NEWMAN lack an explicit recitation of claimed "box" although it is suggested by the PC to Flash Connection discussed by NEWMAN. IKEDA on the other hand, demonstrates the notoriously well-known method of employing a photo-box to organize electronic photographs, e.g., JPEG images—see ST5, FIG. 11., FIG. 14, col. 10, lines 49-53, col. 11, lines 16, 22-26, 34-35, 40, and 41-45; vol. 12, lines 33). it would have been obvious to PHOSITA to combine IKEDA with the combined device described in the rejection of independent claim 1, supra, in order to organize the pictures of HAGIWARA SYS-COM and LIPS in order to control order and content of displayed images, and in order to arrange the JPEG images of the combined device.

47. Per dependent claim 30(28); authenticating a network device was notoriously well-known and would have been implicit in the combination substance of the rejection of claim 28, supra.

48. Claims 31-32 are rejected under 35-U.S.C. 103(a) as obvious over Wo 99/54663 published 04/1998 to HAGIWARA SYS-COM in view of HEATHER NEWMAN FREE PRESS STAFF, W., "Nifty Ways You Can Soup up Your Machine," *Detroit Free Press* No. --, pp. 3E, 08/1999 and further in view of IKEDA et al, US 6,111,586 A (08/2000), hereinafter IKEDA and WO 92/05657 (04/1992) to LIPS GLOEILAMPENFABRIEKEN.

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49. Per dependent claim 31(28) and 32(31); the above combination (dependent claim 28, supra) lacks an explicit recitation of claimed "intervals". However, sequencing photos in intervals was notoriously well-known as taught by LIPS GLOEILAMPENFABRIKEN, substantially set forth in the rejection of independent claim 1, supra. Since the method and motivation for combining this feature of LIPS GLOEILAMPENFABRIKEN in H. SYS-COM was set forth in substantial detail, supra; this would amount to a "copy/ paste" that is otherwise obviated by this explicit incorporation by reference of that part of the rationale set forth in independent claim 1, supra. Per dependent claim 32(31); it would have been obvious to PHOSITA at the time of the invention to set the interval of display in the combined device, given that it was notoriously well-known in the art at the time of the invention to set the frame rate display of displayed photographs.

50. Claims 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/04342 (GOLDMAN) 01/1999 applied for by WEBTV™, in view of DI SANTO et al, US 4,742,345 A 05/1988, hereinafter DI SANTO.

51. Per independent claim 34, WEBTV™ discloses:

A method for distributing picture mail ("The WEBTV™ network services are used in conjunction with software running in a WEBTV™ client system to browse the Web, send electronic mail, and to make use of the Internet in various other ways"—page 4, lines 34-36) to a community ("WEB TV"—col. 4, line 30) of at least one frame device comprising (element

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12— FIG. 3): connecting at least one frame device to an interconnection fabric 29A— FIG. 3, step 901—FIG. 9), said at least one frame device having a border region that comprises a traditional picture frame element 12— FIG. 3); obtaining a configuration number sequence from a memory located in said at least one frame device (default 800 script—element 809—FIG. 8; “WEBTV™ box 10... built into television set 12”—page 6, lines 9-10); using said configuration number sequence to initiate a connection to a data server via said interconnection fabric 809—FIG. 8; obtaining a localized number sequence from said data server 809—FIG. 8; terminating said connection to said data server 803; reconnecting to said data server via said interconnection fabric (“direct dial, bi-directional data connections 29—page 5, lines 5-10 using said localized number sequence 803—FIG. 8.

The Examiner believes each and every claimed element is described in the recited passages of GOLDMAN. However, should Applicant wish to insist that the TV of WEBTV™ does not have a “traditional” frame in a manner consistent with Applicant’s disclosure, it is noted that DE SANTO disclosed a “frame structure illustrated in FIG. 2 comprises a frame structure 30 which may be formed of metal, plastic or the like and have the look of a *conventional picture frame* such as the modern aluminum picture frames employed for photographs or the like.

—col. 13, lines 15-25. It would have been obvious to PHOSITA at the time of the invention to combine the Electrophoretic display of Di Santo with WEBTV™ in order to make Di Santo more compact and able to fit better into corners and small living rooms.

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52. Per dependent claim 35, WEBTV™ discloses: “wherein said localized number sequence is stored in said memory of said frame device” (Flash memory 22b... “the application software 31 and the OS software 32 are stored in flash memory 22b”—page 7, lines 33-35).

53. Per dependent claim 36 (35), WEBTV™ discloses: ‘wherein said at least one frame device utilizes said localized number sequence when said localized number sequence resides in said memory’ (decision step 802 in combination with 809 & 803—FIG. 8)

54. Per dependent claim 37 (34) WEBTV™ discloses: ‘wherein said configuration number sequence is used when said localized number sequence does not reside in said memory’ (decision step 802 in combination with 809 & 803—FIG. 8).

55. Per dependent claim 38 (34) WEBTV™ further discloses: ‘obtaining image data from a data repository accessible via said interconnection fabric.’ (WEB browser —page 7, lines 27-30).

56. Per dependent claim 39 (38) WEBTV™ further discloses: obtaining an onboard software update from said data repository (“an optional upgrade is performed automatically without any input from the client system 1—page 11, lines 30-35).

57. Per dependent claim 40 (39) WEBTV™ further discloses: ‘onboard software update modifies the functionality of said at least one frame device.’ (client system 1 receives... instructions for later execution”—page 8, lines 15-20).

58. Per dependent claim 41 (40) and 42 (41) WEBTV™ further discloses: ‘wherein said at least one frame device determines whether said onboard software update is current’ and ‘obtaining said onboard software update execute when said onboard software update is not

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current' ("The WEBTV™ client system 1 determines... finds a download request in memory" page 10, lines 5-10; "upgrade is determined to be available in step 702..."—page 10, lines 22-35.

59. Per dependent claim 43(34) WEBTV™ further discloses: 'obtaining said configuration number sequence from a memory located in said at least one frame device occurs automatically' (ABSTRACT, FIG. 8).

General Remarks

60. Notwithstanding Applicant's invention as described in the specification, it is believed that Applicant has failed to draft claims around photo screensavers operating on a computer. Many monitors meet the limitation of "traditional frames". The Examiner is personally aware that it was notoriously well-known to distribute photos via e-mail and that it was notoriously well-known to employ photos as screensavers before Applicant's invention. The Examiner does not believe that it will be necessary to provide an affidavit to that effect, some of the prior-art has been provided to substantiate these assertions,

When making an application "special" the Applicant is particularly urged to present claims that are clearly distinguished over these prior art techniques. While the "best" rejection was applied in the interest of "compact prosecution" it is emphasized that many of the claims

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“read on” trading family photographs over the internet, and using family photo graphs as screensavers. These were well-known processes.

PRIOR ART CITED/ NOT EXPLICITLY APPLIED

61. The relevance of the prior art cited can be discerned without undue burden from reading the references provided. The Examiner has endeavored to provide additional information to that in the PTO form 892 (attached hereto) when there is a particular reason for citing a reference which might otherwise be difficult for Applicant to divine.

*US 5,864,387 establishes that it was notoriously well-known to transmit photographs for viewing on a CRT over a network

*US 6,167,469 discloses that it was well-known to trade photos among photo viewing devices over the internet to photo boxes (Abstract, col. 1, lines 10-15, 35-41; col. 2, lines 1-12, 20-25, 34-37, for example)

*WO 00/29960 describes a product market by KODAK which has similar properties to Applicant's invention. The Examiner has been unable to uncover evidence of a prior sale before Applicant's invention. The 25 May 2000 date on this publication is after Applicant's invention.

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*HAGAWARA-SYS-COM, "LUKIS (TM) JPEG Image Viewer (product information)," *web page downloaded from www.hscus.com/prod03* No. n/a, pp. 1-2, 04/2001. describes in laymans terms a product on sale related to the patent publication to H. SYS-COM.

KIRSCHNER, S. K., "Ideas that stick," *Popular Science*, vol. 254 No. 2, pp. 27, 02/1999 describes using a memory stick for pictures and picture frames.

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Conclusion

Any response to this action should be mailed to:

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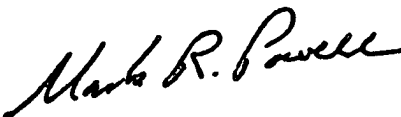
62. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey ROSSI whose telephone number is (703) 308-5213. The Examiner can normally be reached on Monday - Friday from 0830 to 1630 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark POWELL, can be reached on (703) 305-9703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JAR

27 April 2001


MARK R. POWELL
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